Remarks

In the Office Action under reply, one previous rejection has been maintained as follows:

Claims 1, 2, 5, 11-17, 43, and 44 stand rejected under 35 U.S.C. 103(a), as being obvious over Ikariya et al. (U.S. Patent No. 6,184,381).

The other rejections originally issued in the Office Action mailed March 25, 2004 have been withdrawn by the Examiner.

Applicants respectfully further traverse the remaining rejection based on the supplemental remarks that follow.

Status of the Claims and Amendments:

No new amendments to the claims have been submitted for entry. Accordingly, claims 1-47 remain in the application, as previously amended. Claims 1-17 remain under consideration with claims 18-42 withdrawn from consideration as directed to a nonelected invention and species.

Rejections under 35 U.S.C. §103(a) over Ikariya et al.

Claims 1, 2, 5, 6, 11-17, 43, and 44 stand rejected under 35 U.S.C. 103(a), as being obvious over Ikariya et al. (U.S. Patent No. 6,184,381). Applicants respectfully traverse these rejections for at least the following reasons.

In the Office Action issued December 15, 2004, it is asserted that claims 1, 2, 5, 6, 11-17, 43, and 44 are obvious due to the disclosure of other process parameters and/or "analogous reactants" (based on the arguments initially presented in the Office Action dated March 25, 2004, incorporated into the present Office Action under reply) and further since "the reference exemplifies the use of the oxidizing agent acetone."

Applicants continue to respectfully disagree that the claims are properly rejected under §103(a) based on this reference, for reasons noted in the response filed September 24, 2004, and for the following supplemental reasons.

As has been previously noted, the method of claim 1 includes contacting an organic compound with an oxidizing agent and a catalyst comprising a metal composition and a chiral ligand and producing an oxidized organic compound and an enantiomer of the organic

compound. By comparison, applicants have previously argued that Ikariya et al. does not disclose the use of an oxidizing agent in conjunction with a catalyst comprising a metal composition and a chiral ligand. In response, the Examiner has noted that Ikariya et al. exemplifies the use of acetone and has stated that acetone is an oxidizing agent as used by Ikariya et al.

Applicants note, however, that Ikariya et al. does not at all mention or imply that acetone is actually an oxidizing agent, nor is there any apparent reason to conclude that acetone is an oxidizing agent in the disclosed examples. Instead, the instances in which acetone is utilized appear to be related to its use as a solvent not an oxidizing agent (see, e.g., Table 8 at columns 37-38, example 45, in which acetone is noted as a solvent, and in Example 79 at column 47, lines 15-17, wherein acetone also appears to be used as a solvent).

Applicants further note that the position asserted in the Office Action appears to be based on the assumption that acetone "inherently" functions as an oxidizing agent so that its mere disclosure alone is sufficient to suggest applicants' claims. However, inherency requires more than simply a "possibility." Instead, it must be shown that applicants' claimed features are necessarily part of Ikariya et al.'s examples and preparative schemes. (see, e.g., MPEP §2112IV, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993): "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic"; *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981): "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities"; and *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999): "The mere fact that a certain thing may result from a given set of circumstances is not sufficient").

In the present case, there is nothing to clearly suggest that acetone necessarily functions as an oxidizing agent in the examples of Ikariya et al., or as otherwise disclosed therein.

Applicants further note that merely because acetone contains oxygen is not a sufficient reason to conclude that it functions as an oxidizing agent in Ikariya et al. While there may be a possibility that acetone might be an oxidizing agent under the proper circumstances

(dependent on pH, ionic strength, etc.) and for certain kinds of reactions, there is nothing to suggest that the reactions and conditions disclosed by Ikariya et al. necessarily make use of acetone as an oxidizing agent. As such, Ikariya et al. cannot properly be considered to inherently include or suggest such a feature.

In short, Ikariya et al. does not disclose each and every element of the claims, either explicitly by reference to the addition of oxidizing agents, by the use of oxidizing agent compounds in conjunction with a catalyst comprising a metal composition and a chiral ligand, or by a suggestion that such oxidizing agents might be utilized. As such, applicants' claims are not obvious over this reference.

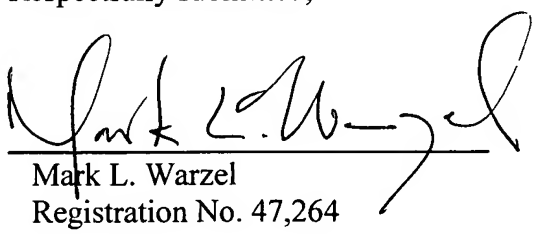
For at least the foregoing reasons, the claims 1, 2, 5, 6, 11-17, 43, and 44 are patentable over Ikariya et al. Accordingly, withdrawal of the rejections under 35 U.S.C. §103(a) is requested.

Conclusion

Accordingly, applicants respectfully submit that the pending claims are novel and nonobvious over the art, and are in condition for allowance. A prompt notice to that effect would be appreciated.

If the Examiner has any questions concerning this amendment, or the accompanying remarks, a telephone call to the undersigned would be appreciated.

Respectfully submitted,

By: 

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